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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of Charles Eldering:

Conf. No.: 3387 : Group Art Unit: 1751
Appln. No.: 09/857,257 : Examiner: Tri V. Nguyen
Filing Date: 01 JUNE 2001 : Attorney Docket No.: T709-12
Title: Advertisement Auction System

Request for Pre-Appeal Brief Conference

Applicant(s) request(s) review of the final rejection in the above-identified application, under the Pre-Appeal Brief Conference Program published on July 12, 2005. No amendments are being filed with this request.

- ☒ The review is requested for the reason(s) stated on the attached sheet(s).
- ☒ Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences is filed herewith.

Date:

8/31/07

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STATEMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Presently, claims 1-9 and 47-76, 78-80 are pending in the application. This paper is being filed in support of the Request for Pre-Appeal Brief Conference submitted herewith. Details of the Examiner's rejections may be found in the Final Office Action dated April 5, 2007 ("Final Office Action") and the Examiner's Advisory Action dated August 17, 2007 ("Advisory Action"). Discussion of the prior art references and the pending claims may be found in Applicant's Amendment filed January 8, 2007 ("Amendment") and Applicant's Response After Final Rejection filed August 6, 2007 ("Response After Final"), both of which are incorporated herein by reference.

No Prima Facie Case of Obviousness

Even though the Examiner has not established a *prima facie* case for obviousness, the Examiner has not withdrawn the rejection of claims 1-9 and 47-76, 78-80 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,253,189 to Feezell et al. ("Feezell") in view of U.S. Patent No. 6,327,574 to Kramer et al. ("Kramer"). A description of Kramer and Feezell may be found on pages 14-15 of the Amendment.

Applicant has submitted that Feezell in view of Kramer does not teach all elements of Applicant's claims. In particular, Feezell in view of Kramer does not teach or suggest "transmitting said correlation factor to said advertiser computer system prior to receiving a bid for said advertisement opportunity from said advertiser computer system; and receiving a successful bid for said advertisement opportunity at said content/opportunity provider computer system, wherein said successful bid results in the transmission of said advertisement to said consumer in said advertisement opportunity," as recited in independent claim 1.

1. Correlation factor not transmitted prior to receiving a bid

The proposed combination of Feezell and Kramer does not teach or suggest "transmitting said correlation factor to said advertiser computer system prior to receiving a bid for said advertisement opportunity from said advertiser computer system." Neither Feezell nor Kramer suggests transmitting a correlation factor to the advertisement computer system prior to receiving a bid. Feezell teaches that a buyer may submit a bid for a non-specific time slot specifying certain demographic characteristics of the predicted audience the buyer desires to reach. Bids in Feezell are submitted without (and before) receiving any "correlation factor." Feezell does teach that information may be provided to the buyer concerning a time slot. However this information does not include a correlation factor, much less a

correlation factor between an advertisement characterization and a consumer. Rather, this information includes “time slot offers, marketing and valuation data, historical transactions, and other data...” None of the data that is provided by Feezell is a correlation factor between a consumer and an advertisement characterization. The information is just a generalized summary of the ad slot itself. Furthermore, this information could not contain a correlation factor between a consumer and an ad characterization because, at the time the buyer receives this information, the buyer has not yet submitted any information which could be used to calculate a correlation factor. According to Feezell, only when the buyer actually submits a bid does the buyer submit any information. Thus, in Feezell, no correlation can be returned until after the bid. Although Feezell’s system does determine whether the offer terms match the bid terms of a buyer, the result of this matching is not communicated to the buyer nor is it a correlation between an ad and a consumer. Feezell simply teaches that time slots are matched according to the bid terms.

Kramer also does not teach that a correlation factor is transmitted prior to receiving a bid. Kramer is not concerned with a bidding process. Rather, Kramer is concerned with presenting the most highly correlated content. Thus, neither of the references individually, nor in combination, teaches nor suggests providing the buyer with a correlation factor between an ad characterization and a consumer. Therefore, the combination of Feezell and Kramer does not teach or suggest “transmitting said correlation factor to said advertiser computer system prior to receiving a bid for said advertisement opportunity from said advertiser computer system.”

2. Overstatement of the teachings and combination

In his rejection of claim 1, the Examiner relies upon Feezell to teach or suggest all portions of claim 1, except for “the use of a correlation factor” (page 4, Final Office Action). Applicant respectfully submits that this reliance is unfounded. Claim 1 recites “calculating a correlation factor between said advertisement characterization and said consumer.” However, Feezell does not disclose an “advertisement characterization.” The Examiner may contend that Feezell provides for the advertiser to submit non-specific bids. But this cannot be an advertisement characterization as recited in claim 1, since aspects (c) and (d) specify that the advertisement characterization is used in a correlation calculation before a bid is received. Since Feezell discloses a “non-specific bid,” it is impossible to provide a correlation factor calculated from the “non-specific bid” (as recited in Feezell) “prior to receiving a bid” (as recited in claim 1). In Feezell, the buyer is only identified as submitting bids and not “advertisement characterizations.”

Furthermore, the Examiner's argument fails when the Examiner contends that Feezell teaches "transmitting said correlation factor to said advertiser computer system." Applicant respectfully points out that the correlation factor in claim 1 is between an advertisement characterization and a consumer. The Examiner argues that Feezell teaches the use of "valuation data, weight factor and correlations," (page 4, Office Action). Simply teaching the usage of these techniques alone cannot be said to teach "transmitting said correlation factor to said advertiser computer system." The "valuation data" described in Feezell is not a result of comparing an advertisement characterization with a consumer so therefore it cannot be the correlation factor described in claim 1. Furthermore, the correlation described by Feezell is between marketing information and "program and time slot information," not between a consumer and an advertisement characterization as described in claim 1. The valuation data in Feezell does not even enable the buyer to know how closely his non-specific bid correlates or compares to an advertising slot. The teaching of a correlation factor, generally, in a reference does not render the usage of all correlation factors obvious. Therefore, since the correlation factor suggested by Kramer has is entirely different from the correlation factor of claim 1, when Krammer's correlation factor is incorporated into the system of Feezell, the resulting combination does not yield all aspects of claim 1. Claim 1 recites "calculating a correlation factor between said advertisement characterization and said consumer...transmitting said correlation factor to said advertiser computer system prior to receiving a bid for said advertisement opportunity..." In Feezell, any information transmitted is not specific to the advertisement characterization and the consumer corresponding to the advertisement. Therefore, in order for the combination of Feezell and Kramer to teach all aspects of claim 1, Kramer would have to teach or suggest calculating such a correlation and transmitting that correlation. Kramer does not.

Additionally, as is clear from the above discussion, Feezell cannot be said to teach "receiving an advertisement characterization," as recited in claim 1, since that advertisement characterization must be available to calculate a correlation before a bid is received.

The notion of providing an advertiser with a correlation of his advertisement characteristics to characteristics of a consumer related to the advertisement opportunity is also not found in either of the references nor their combination.

The Examiner argues that "It would be obvious to a skilled artisan that all the pertinent information are received prior to making a bid in order to effectively determine opportunity and optimize the decision making process." In other words, the Examiner contends that providing any "pertinent information" to an advertiser is obvious to one skilled in the art, regardless of how the information is

generated or where it comes from. The Examiner fails to acknowledge that there is a difference between providing the valuation information that Feezell teaches, and the correlation factor that is customized according to the advertisement characterization submitted by the advertiser. Feezell's valuation information is simply generalized information, whereas claim 1 recites a correlation factor specific to the advertisement characterization and the consumer to which the advertisement opportunity corresponds.

Therefore, even if the correlation factor that the Examiner argues is taught by Kramer is substituted into the system of Feezell, the combination would still not teach all aspects of claim 1. This is because Feezell teaches matching a non-specific bid with an ad slot having a demographic. Therefore, modifying Feezell with a correlation factor would result in the calculation of the correlation between the non-specific bid and the ad slot. This does not teach all aspects of claim 1 at least because an ad slot (with associated demographic information) is not the same as a consumer. An ad slot is an available slot having likely viewership information in which to display an ad there is no guarantee that the ad will be presented to any consumer, let alone one with characteristics correlated to an advertisement. Accordingly, the combination of Feezell and Kramer does not teach all aspects of claim 1.

3. No motivation to combine; combination changes the principle of operation of the primary reference

The proposed modification of Feezell with Kramer would change the principle of operation of the primary reference, and therefore, the two references are not properly combinable. As the Examiner is well aware, "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." See *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); MPEP § 2143.01. The systems of Feezell and Kramer are incompatible and not interchangeable because they work on different paradigms, with Feezell matching "non-specific" bids with time slots, while Kramer teaches matching consumers to content. In other words, Feezell provides "a method for completing advertising time slot transactions," (abstract) whereas Kramer provides for "selecting the variable content alternatives encoded in the structured documents that most closely match the consumer's profile" (abstract).

Since Feezell does not disclose submitting an advertisement characterization before bidding, the combination would cause a significant change to the described function of Feezell. If the two references were combined, in addition to the adding of the correlation factor, a submission of an advertisement characterization - undisclosed in either reference - would be needed. Furthermore, the individual consumer

granularity offered by Kramer would likely require a substantial redesign of the system of Feezell. Since this would require changes to the principle of operation of Feezell, Feezell and Kramer are not properly combinable.

Since there is no motivation to combine Feezell and Kramer and, even if the combination is proper, it does not teach all aspects of independent claim 1, independent claim 1 is believed to be patentable over the proposed combination of Feezell and Kramer.

Independent claims 52, 63, and 71 are believed to be patentable over the combination of Feezell and Kramer. Further discussion of these claims may be found on page 7-9 of the Response After Final.

The Examiner has also failed explain how the combination of Feezell and Kramer teaches all aspects of dependent claim 57. Applicant submits that claim 57 is patentable for at least the same reasons as independent claim 52. Furthermore, the Examiner argues that the proposed combination of Feezell and Kramer "do not explicitly disclose wherein the value of said successful bid is dependent on the correlation factor transmitted in step (d)," and that Feezell "discloses the successful bid is based on the valuation data," (Office Action, page 15). The Examiner does not explain how valuation data is equivalent to a correlation factor nor how the bid in Feezell depends on the valuation data. Feezell does not describe what valuation data is. However, it is clear from Feezell that valuation data is not a correlation factor because at the time the valuation data is provided to the buyer, the buyer has submitted no information that could be correlated or even compared. Thus, claim 57 is believed to be patentable over the proposed combination because there is no motivation to combine Feezell and Kramer and even if the combination is proper, it does not teach all aspects of claim 57.

Dependent claims 2-4, 6-8, 47-51, 53-58, 60-62, 64-70, 72-76, and 78-80 are allowable at least by dependency on independent claims 1, 5, 52, 59, 63, and 71, respectively. Dependent claim 9 has been rejected under 35 U.S.C. § 103 as being unpatentable over Feezell in view of Kramer in further view of U.S. Patent No. 5,835,896 to Fisher et al. ("Fisher"). Thus, dependent claim 9 is believed to be allowable at least by its dependency on independent claim 1 (see Response After Final, page 9). Reconsideration and withdrawal of the Examiner's rejection of claim 9 are respectfully requested.

Applicant respectfully submits that the Examiner's rejections have been previously overcome, and that the application, including claims 1-9 and 47-80, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and a Notice of Allowance are respectfully requested.